

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 4, 7, 10-12, 20-22, 29 and 30 are pending in the application. No new matter has been added. Reconsideration of the claims is respectfully requested.

In paragraph 4 on page 2 of the Official Action, Claims 4, 7, 10, 12, 20-22 and 29-30 were rejected under 35 USC § 103(a) as being unpatentable over Capps (US Publication 2002/0111813) in view of Lloyd-Jones (US Publication 2002/0055955), and further in view of Goldberg (US Publication 2004/0008872). In paragraph 20 on page 10 of the Official Action, Claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Capps, Lloyd-Jones and Goldberg, in view of Davis et al. (US Publication 2002/0001395). Applicants respectfully traverse the rejections.

Applicants respectfully contend that a *prima facie* case of obviousness has not been established, as described more fully below. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.
(M.P.E.P. §2142).

Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *Id.* Broad conclusory

statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

First, with respect to claim 4, as admitted by the Office Action Capps fails to disclose an image content identifier. Accordingly, Capps cannot teach or suggest the image content identifier having an associated electronic address of a second party. It also follows that Capps cannot possible teach or suggest at least determining if a portion of said at least one digital image file matches the image content identifier having an associated electronic address of a second party when Capps does not disclose an image content identifier.

Goldberg fails to remedy the deficiencies of Capps as Goldberg fails to teach or suggest at least determining if a portion of said at least one digital image file matches an image content identifier having an associated electronic address of a second party. Goldberg merely discloses that during initial registration of patrons, electronic images of all the patrons are stored in a database. [0107, 0142, 0144]. Subsequent to registration, captured images of the patrons are searched for in the database. The patron will then access these stored images at a distribution center. [0146]. Goldberg does not even disclose an image content identifier, much less, an image content identifier having an associated electronic address of a second party.

Lloyd-Jones fails to remedy the deficiencies of Capps and Goldberg as Lloyd-Jones fails to teach or suggest determining if a portion of said at least one digital image file matches an image content identifier having an associated electronic address of a second party. Rather, Lloyd-Jones discloses a user that can annotate an image by associating metadata with icons and then dropping the icon on an image. [29, 30]

Second, with respect to claim 4, as admitted by the Office Action Capps fails to disclose automatically forwarding a digital image to an identified second party.

Goldberg fails to remedy the deficiencies of Capps as Goldberg fails to teach or suggest automatically forwarding said digital image from said first party to said electronic address of said second party over said communication network if said image content identifier matches a portion of said image. Rather, Goldberg discloses that patrons will access stored images at image distribution centers. [0146].

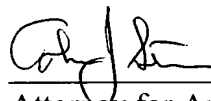
Lloyd-Jones fails to remedy the deficiencies of Capps and Goldberg as Lloyd-Jones fails to teach or suggest automatically forwarding said digital image from said first party to said electronic address of said second party over said communication network if said image content identifier matches a portion of said image. Rather, Lloyd-Jones discloses e-mail addresses are associated with icons. However, in Lloyd-Jones, the e-mail is not automatic and is initiated by a user. [0039].

It is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fourth applied prior art reference to Davis is moot, inasmuch as the combination of Capps, Goldberg, Lloyd-Jones and Davis still lack any teaching, disclosure, or suggestion concerning a content identifier having an associated electronic address of a second party as previously discussed.

Therefore, in view of the above remarks, Applicants claim 4 is patentable over the cited references. Rejected independent claims 7, 10, 12, 20-22 and 29 recite one or more feature generally similar to those of claim 4 discussed above. Accordingly, for similar reasons as discussed above, independent claims 7, 10, 12, 20-22 and 29 are believed to be patentable over the cited references.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.